



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,793	06/26/2001	David J. Ecker	DIBIS-0003US	1490
58057	7590	09/13/2006		
MEDLEN & CARROLL LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105				
EXAMINER FREDMAN, JEFFREY NORMAN				
ART UNIT 1637				
PAPER NUMBER				

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,793

Applicant(s)

ECKER ET AL.

Examiner

Jeffrey Fredman

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. Claims 69-104 are pending.

Claims 69-104 are rejected.

Any rejection which is not reiterated in this action is hereby withdrawn as no longer applicable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 69-104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As MPEP 2163.06 notes " If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen , 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)."

Here, claim 69 (and the other independent claims) incorporate a range of 8 in the comparison of calculated bioagents and this number and new range is apparently new matter. A careful review by the examiner of the cited pages of the specification failed to identify any support for this new limitation. The citation to Figure 14 does not support a

comparison to 8, since the listed eight elements are not comparable and the figure shows much more than 8 elements. The eight elements listed include species such as hepatitis A virus and includes genera such as Rhinovirus, which includes dozens if not hundreds of members. So Rhinovirus is not a single "bioagent" as per claim 1. As noted by MPEP 2163.05,

"With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure."

In this case, no basis for the range of 8 or more bioagents has been identified in the original disclosure. The disclosure at figure 14 shows at least 25-30 different different results, not 8. This conclusion is consistent with the decision of the Federal Circuit in Eiselstein v. Frank 34 USPQ2d 1467, 1471 (Fed. Cir. 1995), where the Court noted "Moreover, the 10% range of 45-55%, even if it is an approximate "about" 45-55%, is not the same as a very different 10% range, viz., 50-60%. The limits of these ranges vary from each other by about 10%, which is comparable to the extent of the variation within each range. Eiselstein has therefore not persuaded us that the Board clearly erred in finding that the grandparent application did not provide an adequate written description of the invention comprising 50-60% nickel." Thus, the Federal Circuit did not permit a range shift where the prior range was disclosed in a way inherently shown in the specification. The change in the current case is greater since there is no support for the specific range chosen whatsoever. Since no basis has been found to support the new claim limitation in the specification, the claim is rejected as incorporating new matter.

Claim Rejections - 35 USC § 102

4. The rejection of claims 69-74, 79, 80, 82-90, 95, 96 and 98-100 under 35 U.S.C. 102(b) as being anticipated by Fluit et al (WO 95/13396) are withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

5. The rejection of claims 75, 76, 91 and 92 under 35 U.S.C. 103(a) as being unpatentable over Fluit et al (WO 95/13396) in view of Iliff et al (U.S. Patent 6,475,143) are withdrawn in view of the amendment and the declaration.

6. The rejection of claims 77, 78, 93 and 94 under 35 U.S.C. 103(a) as being unpatentable over Fluit et al (WO 95/13396) in view of Muddiman et al (Anal. Chem. (1996) 68:3705-3712) are withdrawn in view of the amendment and the declaration.

7. The rejection of claims 81 and 97 under 35 U.S.C. 103(a) as being unpatentable over Fluit et al (WO 95/13396) in view of Lebedev et al (Genetic Analysis: Biomolecular Engineering (1996) 13:15-21) are withdrawn in view of the amendment and the declaration.

Double Patenting

8. The double patenting rejections are withdrawn in view of the terminal disclaimers which were filed.

Response to Amendment

9. The Declaration under 37 CFR 1.132 filed August 11, 2006 is sufficient to overcome the rejection of claims based upon 35 U.S.C. 103.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

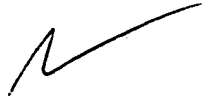
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey Fredman
Primary Examiner
Art Unit 1637

9/2/06